

DETAILED ACTION

Claims should be preceded by an article, e.g. *a* or *the*.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's claims are drawn to "avoiding wanted differentiation" which would seem oxymoronic and as such applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Also, claim 1 requires the step of "obtaining generated stem cells" but does not delineate where these cells are in fact generated.

Claim 11 is drawn to a culture medium but has detail of only one ingredient which unto itself would not be a culture medium. Please note that the language of a claim must make it clear what subject matter the claim encompasses to adequately delineate its "metes and bounds". See, e.g., the following decisions: *In re Hammack*, 427 F.2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); *In re Venezia* 530 F.2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F.2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); *In re Watson*, 517 F.2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); *In re Knowlton* 481 F.2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: *In re Steele*, 305 F.2d. 859, 134 USPQ 292 (CCPA 1962); *In re Moore* 439 F.2d. 1232, 169 USPQ 236 (CCPA 1969); *In re Merat*, 519 F.2d. 1390, 186 USPQ 471 (CCPA 1975).

Claim 12 provides for the use of region-modified glycans, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite

Art Unit: 1651

where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 13 and 14 also add no steps to the method of claim 1 and as such it is unclear what the intended claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Gupta et al(as cited by applicant).

Claim 11 is drawn to a one component composition and because that one component is not novel, the claimed invention is not novel.

Gupta teaches compounds in composition which read on the compound designated in the claimed composition. The reference anticipates the claim subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLAINE LANKFORD JR whose telephone

Art Unit: 1651

number is (571)272-0917. The examiner can normally be reached on Mon-Fri 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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